

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KIRT E. WHITESIDE

Appeal No. 2003-1649
Application No. 09/523,469

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 16 and 19 to 25, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a mechanic's creeper having an improved side rail and caster assembly providing a more contoured fit for the user, improved resistance to wear and tear, and a lack of protrusions on the side rails so as to avoid the snagging and tearing of clothes and possible scratches to the user's body (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Jarvis	1,882,497	Oct. 11, 1932
Happ	2,487,706	Nov. 8, 1949

Claims 1 to 3, 8 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Happ.

Claims 4 to 7, 9 to 16, 19, 20 and 22 to 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Happ in view of Jarvis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed January 10, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed October 29, 2002) and reply brief (Paper No. 15, filed February 21, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 16 and 19 to 25 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Rejection based on Happ alone

We will not sustain the rejection of claims 1 to 3, 8 and 21 under 35 U.S.C. § 103 as being unpatentable over Happ.

Claims 1 and 21, the only independent claims subject to this ground of rejection, read as follows:

1. A creeper comprising opposed side rails; a pad supported between said side rails; and a plurality of caster assemblies supporting said side rails; said side rails having planar top and bottom surfaces, said top surface tapering toward said bottom surface to define a decreased cross section of said side rails, the decreased cross section of said side rails being positioned, adjacent said pad; said caster assemblies being positioned wholly under and attached solely to said bottom surface of said side rails.

21. A creeper comprising opposed hollow side rails, each having a top surface spaced from a generally horizontal bottom surface by opposed arcuate surfaces to define a cavity therebetween; a pad supported between said side rails; and a plurality of caster assemblies supporting said side rails and attached thereto with a fastener extending through said bottom surface into said cavity without creating a protrusion on said top surface of said side rails.

Happ discloses that a creeper 10 includes casters 12 secured by brackets 14 which are pivotally mounted on base 24 by stud shafts 18 as is well known in the art.¹ As shown in the drawings the base 24 has a circular cross section and forms a substantially rectangular base to which body member 16 is rigidly secured. A second body member 28 is pivoted by hinges 26 to the body member 16. A head rest 32 is provided on the body member 28.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Happ and claim 1, it is our opinion that the differences are: (1) the side rails having planar top and bottom surfaces, the top surface tapering toward the bottom surface to define a decreased cross section of the side rails, the decreased cross section of the side rails being positioned, adjacent the pad; and (2) the caster assemblies being positioned wholly under and attached solely to the bottom surface of the side rails. Based on our analysis and review of Happ and claim 21, it is our opinion that the differences are: (1) each hollow side rail having a generally horizontal bottom surface; and (2) a plurality of caster assemblies attached to the side

¹ The precise manner of mounting the stud shafts 18 to the base 24 is not disclosed by Happ.

rails with a fastener extending through the bottom surface without creating a protrusion on the top surface of the side rails.

In the rejection of claims 1 and 21 (answer, p. 3), the examiner (1) stated that "the shape of the side rails is not patentable because it does not produce an unexpected result other than increased comfort, which is believed to be a well-known and expected result;" and (2) concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to "have given the creeper side rails, as taught by Happ, a tapered, tear shape, in order to increase comfort and obstruction of a user."

The appellant argues that Happ does not suggest the claimed subject matter. We agree. The examiner made a determination that the differences between the subject matter of claims 1 and 21 and the subject matter taught by Happ would have been obvious to an artisan, however, this determination has not been supported by any evidence that would have led an artisan to arrive at the claimed invention. Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996),

Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Since the examiner has not presented evidence establishing it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Happ to arrive at the subject matter of claims 1 and 21, the decision of the examiner to reject claims 1 and 21, and claims 2, 3 and 8 dependent hereon, under 35 U.S.C. § 103 is reversed.

Rejection based on Happ and Jarvis

We will not sustain the rejection of claims 4 to 7, 9 to 16, 19, 20 and 22 to 25 under 35 U.S.C. § 103 as being unpatentable over Happ in view of Jarvis.

Jarvis' invention relates to improvements in bearing construction. As shown in the drawings, a top or swivel plate 1 is provided with a ball race 4. The swivel plate 1 is attached to a retaining object 5 by means of bolts 6. A pintle 7 is inserted in an opening 2 of the swivel plate 1. Wheel 26 is supported by plates 23. Plates 23 are connected to top bracket 18 by rivets 25. Top bracket 18 is provided with a ball race 19 and ball bearing members 21 are secured between races 4 and 19.

With respect to dependent claims 4 to 7, 9 to 12 and 22 to 24, we have reviewed the teachings of Jarvis additionally applied in the rejection of claims 4 to 7, 9 to 12 and 22 to 24 but find nothing therein which makes up for the deficiencies of Happ discussed above regarding claims 1 and 21. Accordingly, we cannot sustain the examiner's rejection of appealed claims 4 to 7, 9 to 12 and 22 to 24 under 35 U.S.C. § 103.

Claims 13 and 25, the only independent claims subject to this ground of rejection, read as follows:

13. A creeper comprising hollow opposed side rails, each having a top surface spaced from a bottom surface by opposed arcuate surfaces to define a cavity therebetween; a pad supported between said side rails; and a plurality of caster assemblies each including a top bearing bracket having a top race, said top bearing bracket being attached to said bottom surface by a fastener extending through said bottom surface into said cavity such that no protrusion extends through said top surface, wherein said top race of said top bearing bracket lies wholly within the vertical profile of said side rail.

25. A creeper comprising opposed side rails of a tapered cross section, each having a top and bottom surface; and a plurality of caster assemblies attached to and supporting said side rails, said caster assemblies each including a top bearing bracket attached to only the bottom surface of said side rails and providing a top race that lies wholly within the vertical profile of said side rail, each said caster assembly also including a kingpin holding said caster assembly in operative relation, wherein said kingpin does not extend through said top surface of said side rail.

Based on our analysis and review of Happ and claim 13, it is our opinion that the differences are: (1) a plurality of caster assemblies each including a top bearing bracket having a top race; (2) the top bearing bracket being attached to the bottom surface of the side rail by a fastener extending through the bottom surface into the cavity such that no protrusion extends through the top surface of the side rail; and (3) the top race of the top bearing bracket lies wholly within the vertical profile of the side rail. Based on our analysis and review of Happ and claim 25, it is our opinion that the difference is a plurality of caster assemblies each including a top bearing bracket attached to only the bottom surface of the side rails and providing a top race that lies wholly within the vertical profile of the side rail.

In the rejection of claims 13 and 25 (answer, p. 4), the examiner (1) concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to "have given the creeper, as taught by Happ, the caster assembly, as taught by Jarvis, in order to secure the casters to the side rails without the

need for welding; and (2) stated that "the shape of the side rails is not patentable because it does not produce an unexpected result other than increased comfort which is believed to be well-known and expected."

The appellant argues that the combined teachings of Happ and Jarvis do not suggest the claimed subject matter. We agree. In our opinion while it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Happ's casters 12 to be built in the manner taught by Jarvis, this modification of Happ does not result in the claimed subject matter. In that regard, neither Happ or Jarvis discloses a top race that lies wholly within the vertical profile of the side rail and such a modification to Happ is not suggested by the applied prior art. Accordingly, the decision of the examiner to reject claims 13 and 25, and claims 14 to 16, 19 and 20 dependent hereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 16 and 19 to 25 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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